



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,096	11/17/2003	Shoko Yoshida	117791	2226

25944 7590 12/27/2007
OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3628

MAIL DATE	DELIVERY MODE
-----------	---------------

12/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,096

Applicant(s)

YOSHIDA ET AL.

Examiner

Igor N. Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-10,15 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-10 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

Amendment received on 12/06/2007 is acknowledged and entered. Claim 15 has previously been withdrawn. Claims 5, 6, 11-14, 16-25 have previously been canceled. Claims 1, 4, 7-9 have been amended. Claims 1-4, 7-10, 15 and 26-28 are currently pending in the application.

Claim Rejections - 35 USC § 112

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 7-10, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al. (EP 1 028 386 A2) in view of Chefalas et al. (US 2002/0138786 A1).

Berstis et al. teaches a computer-implemented method for customer registration, comprising:

Claims 1, 7 and 8,

receiving customer information inclusive of information about a customer that purchased merchandise and information about the merchandise that the customer purchased, sent from the customer; storing the received customer information onto a

storage device and performing a customer registration as a purchaser of the merchandise; and transmitting information advising to perform a membership registration different from the customer registration to the customer, after completing the customer registration (transmitting a rebate to the consumer for completing on-line warranty registration), wherein the membership registration is performed in order for the registered customer to receive a service (warranty service) related to the merchandise that the customer purchased [0018]-[0023].

Berstis et al. does not specifically teach that said receiving a *service (warranty service)* related to the merchandise that the customer purchased includes a *web service*.

Chefalas et al. teaches a method for on-line product support, wherein warranty services, including repair or trouble-shooting of customer's product, are conducted on-line [0013]; [0008]; [0004].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis et al. to include that said receiving a *service (warranty service)* related to the merchandise that the customer purchased includes a *web service*, as disclosed in Chefalas et al., because it would advantageously require less effort for a customer to receive a customer support, as specifically stated in Chefalas et al. Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Berstis et al. and Chefalas et al. does not specifically teach that said registration also can be performed by a member who does not purchase the merchandise.

However, the fact that said registration also can be performed by a member who

does not purchase the merchandise does not affect the method steps performed. The claimed method steps still require performing the membership registration for the customer who purchased the product regardless who else can conduct said registration. Furthermore, the claimed method steps do not require that said registration also *is performed* by a member who does not purchase the merchandise, but merely indicate a possibility of conducting said registration step.

MPEP 2106 (C) states: "Language that *suggests or makes optional but does not require steps to be performed* or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Therefore, information as to "that said registration also can be performed by a member who does not purchase the merchandise" is non-functional language and given no patentable weight.

Claims 2, 4, 9, 26 and 28, see reasoning applied to claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al. in view of Chefalas et al. and further in view of Keen et al. (US 5,774,882).

Claim 3. Berstis et al. in view of Chefalas et al. teaches all the limitations of claim 3, except specifically teaching that the customer information includes information about whether a customer is a corporation or an individual, and only when the customer is an individual, information advising the membership registration is transmitted.

Keen et al. (Keen) teaches a method for customer registration, including a step of obtaining information whether the applicant is a corporation or an individual to be processed differently (C. 3, L. 34-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Meyer to include that the customer information includes information about whether a customer is a corporate or an

individual, and only when the customer is an individual, information advising the membership registration is transmitted, as suggested by Keen, because it would advantageously allow to tailor said method to a particular type of consumers, thereby increase effectiveness and potentially generate more revenue.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al. in view of Chefalas et al. and further in view of Fisher et al. (US 6,771,801 B1).

Claim 27. Berstis et al. in view of Chefalas et al. teaches all the limitations of claim 3, except specifically teaching that the customer registration is performed as a purchaser of a camera; and the membership registration is performed to receive an on-line album service in that image data of the customer can be stored up to a certain capacity.

Fisher et al. teaches a method for providing an on-line photograph album service, thereby suggesting providing said services for camera purchasers (C. 3, L. 10-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis et al. in view of Chefalas et al. to include that the customer registration is performed as a purchaser of a camera; and the membership registration is performed to receive an on-line album service in that image data of the customer can be stored up to a certain capacity, as disclosed in Fisher et al., because it would advantageously allows the user to start with a created by a professional basic album template, and adapt that template to the particular images the user has, as specifically stated in Fisher et al. (C. 2, L. 65-67).

2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 7-10, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al. (EP 1 028 386 A2) in view of Chefalas et al. (US 2002/0138786 A1) and further in view of Forlai (US 7,243,082 B1).

Berstis et al. teaches a computer-implemented method for customer registration, comprising:

Claims 1, 7 and 8,
receiving customer information inclusive of information about a customer that purchased merchandise and information about the merchandise that the customer purchased, sent from the customer; storing the received customer information onto a storage device and performing a customer registration as a purchaser of the merchandise; and transmitting information advising to perform a membership registration different from the customer registration to the customer, after completing the customer registration (transmitting a rebate to the consumer for completing on-line warranty registration), wherein the membership registration is performed in order for the registered customer to receive a service (warranty service) related to the merchandise that the customer purchased [0018]-[0023].

Berstis et al. does not specifically teach that said receiving a *service (warranty service)* related to the merchandise that the customer purchased includes a *web service*.

Chefalas et al. teaches a method for on-line product support, wherein warranty services, including repair or trouble-shooting of customer's product, are conducted on-line [0013]; [0008]; [0004].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis et al. to include that said receiving a *service (warranty service)* related to the merchandise that the customer purchased includes a *web service*, as disclosed in Chefalas et al., because it would advantageously require less effort for a customer to receive a customer support, as specifically stated in Chefalas et al.

Berstis et al. and Chefalas et al. does not specifically teach that said registration also can be performed by a member who does not purchase the merchandise.

Forlai teaches a method for registering buyers, comprising registering selected individuals as potential buyers (Abstract), thereby indicating registering a member (individual) who does not purchase the merchandise (potential buyer).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis et al. and Chefalas et al. to include that said registration also can be performed by a member who does not purchase the merchandise, as disclosed in Forlai, because it would advantageously allow the Web site owner to market accumulated potential registered buyers, thus generating a substantial revenue, as specifically stated in Forlai (C. 4, L. 41-43). Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board

decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claims 2, 4, 9, 26 and 28, see reasoning applied to claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al. in view of Chefalas et al., further in view of Forlai and further in view of Keen et al. (US 5,774,882).

Claim 3. Berstis et al. in view of Chefalas et al. and further in view of Forlai teaches all the limitations of claim 3, except specifically teaching that the customer information includes information about whether a customer is a corporation or an individual, and only when the customer is an individual, information advising the membership registration is transmitted.

Keen et al. (Keen) teaches a method for customer registration, including a step of obtaining information whether the applicant is a corporation or an individual to be processed differently (C. 3, L. 34-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis et al., Chefalas et al. and Forlai to include that the customer information includes information about whether a customer is a corporate or an individual, and only when the customer is an individual, information advising the membership registration is transmitted, as suggested by Keen, because it would advantageously allow to tailor said method to a particular type of consumers, thereby increase effectiveness and potentially generate more revenue.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis et al. in view of Chefalas et al., further in view of Forlai and further in view of Fisher et al. (US 6,771,801 B1).

Claim 27. Berstis et al. in view of Chefalas et al. and further in view of Forlai teaches all the limitations of claim 3, except specifically teaching that the customer registration is performed as a purchaser of a camera; and the membership registration is performed to receive an on-line album service in that image data of the customer can be stored up to a certain capacity.

Fisher et al. teaches a method for providing an on-line photograph album service, thereby suggesting providing said services for camera purchasers (C. 3, L. 10-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis et al., Chefalas et al. and Forlai to include that the customer registration is performed as a purchaser of a camera; and the membership registration is performed to receive an on-line album service in that image data of the customer can be stored up to a certain capacity, as disclosed in Fisher et al., because it would advantageously allows the user to start with a created by a professional basic album template, and adapt that template to the particular images the user has, as specifically stated in Fisher et al. (C. 2, L. 65-67).

Response to Arguments

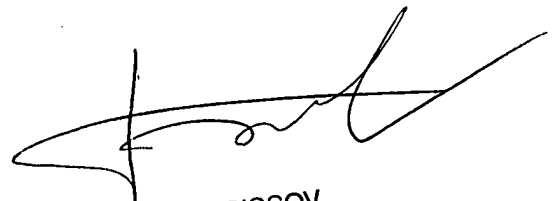
Applicant's arguments with respect to claims 1-4, 7-10, 15 and 26-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
12/14/2007



IGOR N. BORISSOV
PRIMARY EXAMINER